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Docket 79770F-P  
Customer No. 01333

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

David L. Patton, et al

SYSTEM FOR CUSTOMIZING  
AND ORDERING  
PERSONALIZED POSTAGE  
STAMPS

Serial No. US 09/378,159

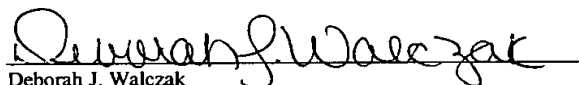
Filed 19 August 1999

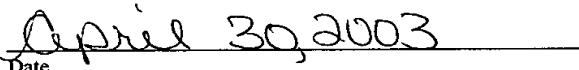
Commissioner for Patents  
Box AF  
Washington, D.C. 20231

Group Art Unit: 3629

Examiner: Naresh Vig

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Sir:

**APPEAL BRIEF TRANSMITTAL**

Enclosed herewith in triplicate is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

  
Attorney for Appellants  
Registration No. 27,370

Frank Pincelli/djw  
Telephone: (585) 588-2728  
Facsimile: (585) 477-4646  
Enclosures



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Deborah J. Walczak

April 30, 2003  
Date

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GROUP 3600

**APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192**

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## **APPELLANT'S BRIEF ON APPEAL**

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-4, 6-26 and 28-55 which was contained in the Office Action mailed January 7, 2003.

A timely Notice of Appeal was filed April 3, 2003.

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### **Real Party In Interest**

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

### **Related Appeals And Interferences**

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

### **Status Of The Claims**

Claims 1-4, 6-26 and 28-55 have been rejected.

Appendix I provides a clean, double spaced copy of the claims on appeal.

### **Status Of Amendments**

All of the amendments have been entered and the claims stand as indicated in Appendix I.

### **Summary Of The Invention**

The present invention is directed to a method, system and software product that allows for the ordering of an Official Postal Stamp 27 whereby the essential authority or computer system 12 communicates over a communication system with at least one remote ordering system 14. The central authorizing computer system allows affording of information to the remote ordering system for allowing customizing of an Official Postal Stamp by a user from the remote ordering system whereby the user may provide an image for incorporation as a part of the Official Postal Stamp.

## **Issues For Review By The Board**

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1-4, 6-26 and 28-55 are unpatentable under 35 USC § 102(e) as being unpatentable over Kara1, US Patent 5,819,240 in view of Brasington et al., US Patent 5,923,406.

## **Grouping Of Claims**

Group I: Claims 1-4, 6-26 and 28-55.

## **Arguments**

### ***The Rejection***

#### ***Group I - Claims 1-4, 6-26 and 28-55***

- A. The Examiner in the Official Action dated January 7, 2003 rejected claims 1, 32, 42, 49-50, 52, 54-55 for the reasons set forth therein.

Independent claims 1, 32, 42, 49-50 and 52 are directed to system, method or software for ordering the customization of an Official Postal Stamp. An important part of the customized personal images on a stamp that can be used freely by the user or by other individuals. In the present invention images provided by the user are made a part of the Official Postal Stamp. The Official Postal Stamp according to the present invention is directed to a small piece of paper that is sold by a government for affixing to an article to be mailed. See Webster's II definition of the word "stamp" (Exhibit A, attached). Also, see Figs. 4 and 5 of the present application (Exhibit B) which illustrates the individual stamps that may be ordered according to the present invention. As can be seen, the Official Postal Stamps of the present invention are not directed to metered postage. The Kara et al. reference (Kara1) is directed to metered postage as opposed to an Official Postal Stamp that incorporates personal images. The Kara1 reference teaches away from the use of stamps. (See abstract of Kara1 and column 1, lines 30-36 and column 2, lines 12-30. The Kara1 reference discusses many of the disadvantages of providing an Official Postal Stamp. This is in complete contrast to the present invention which is indeed directed to an Official Postal Stamp. The Examiner in the Advisory Action states:

"Applicant argues that references cited are directed to metered postage stamps as opposed to official postage stamps. Examiner does not agree. Metered

postage stamps are authorized by the postal authority and the references teaches the claims of the applicant as explained in the offices actions."

Applicant respectfully submits that the Examiner is incorrect. As previously noted the Kara1 reference is specifically directed to metered postage and teaches away from official postage stamps. Kara1 specifically points out the disadvantages of providing stamps.

Applicants provide an invention whereby personal images can be used on Official Postal Stamps which overcome many of the problems of the prior art. In particular, the present invention requires an authorizing agency to assure that the appropriate images are being provided for use on the Official Postal Stamps. The stamps of the present invention are fungible and useable by a variety of users thereby allowing the original purchaser to use the stamps not only as official postage but also for being used on envelopes to be returned to the sender. As previously noted, Kara1 is directed to metered postage that is placed directly on the product to be mailed and/or on a label that is used in mailing. There is no teaching or suggestion in Kara1 of providing an Official Postal Stamp that can be used by anyone that incorporates images supplied by the user as taught and claimed by applicant.

The present invention can be further distinguished from Kara1 in that the present invention includes an authorizing computer system which communicates with at least one remote ordering system over a communication network. The central authorizing computer system has a computer program for forwarding information to at least one remote ordering system. The Kara1 reference does not teach or suggest the remote ordering of postal stamps as previously discussed. Kara1 discloses the providing of additional postage credit to the postal metering system. There is no ordering of Official Postal Stamps as taught and claimed by applicants. Furthermore, the present invention allows the user to provide images that are incorporated as a part of the Official Postal Stamp. The present invention allows customizing of an Official Postal Stamp by a user from a remote ordering system whereby the user provides an image for incorporation as a part of the Official Postal Stamp. Kara1 fails to teach or suggest the incorporation of the user provided image into an Official Postal Stamp.

The Brasington et al. reference discloses a vending machine for printing postage stamps. In Brasington et al there is no system whereby an authorizing computer can communicate over a communication network with at least one remote ordering system. Brasington et al. is directed to a stand alone vending device. Further, since this reference is directed to selling stamps there would be

no motivation or suggestion of combining this with the Kara1 reference as the Kara1 reference is directed to the production of metered stamps and not the use of Official Postal Stamps. Thus, there would be no motivation or suggestion for the combining of the references as suggested by the Examiner.

With respect to the rejection of claims under 35 USC § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In doing so, the Examiner is expected to make a factual determination as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) and to provide the reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to combine the prior art references to arrive at the claimed invention. Such reason must stem from teaching, suggestion or implication in the prior art as a whole or knowledge generally available to having ordinary skill in the art. These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. In the present instance the Examiner has ignored the difference between an Official Postal Product Stamp and metered postage. Applicants respectfully submit that the Examiner has not meant his burden of illustrating that the features of the present invention are taught by the prior art or there is some teaching or suggestion in the prior art as a whole to combine the references as suggested by the Examiner. As previously noted, the Kara1 reference is directed to metered postage and not Official Postal Stamps as taught and claimed by applicants and the Brasington reference is directed to a vending machine for producing postage stamps which is totally apart and distinct from the Kara1 reference. The two cited references are directed to two totally different type systems for providing two totally different products. As previously noted, Kara1 is specifically directed to avoiding the problems of providing Official Postal Stamps and thus, there would be no motivation or suggestion to make the combination as suggested by the Examiner.

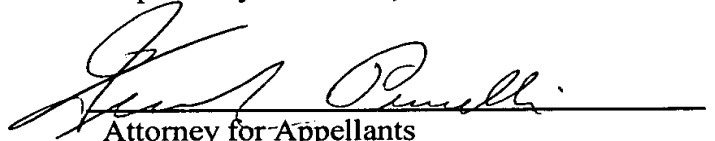
### **Summary**

In summary, applicants respectfully submits that the present invention is patentably distinct over the prior art.

**Conclusion**

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-4, 6-26 and 28-55

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Frank Pincelli", is written over a horizontal line.

Attorney for Appellants  
Registration No. 27,370

Frank Pincelli/djw  
Telephone: (585) 588-2728  
Facsimile: (585) 477-4646  
Enclosures



## **Appendix I - Claims on Appeal**

1. A system for ordering a custom official postal stamp, comprising:  
  
a central authorizing computer system for communicating with at least one remote ordering system over a communication network, said central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for allowing customizing of an Official Postal Stamp by a user from said at least one remote ordering system wherein the user provides an image for incorporation as a part of said official postal stamp.
2. A system according to claim 1 wherein said at least one remote ordering system comprises a microprocessor having communication software.
3. A system according to claim 2 wherein said at least one remote ordering system comprises a personal computer.
4. A system according to claim 1 wherein said information includes instructions on how to modify an image for use on a postal stamp or for ordering said customized official postal stamp.

6. A system according to claim 1 wherein said information includes a list of acceptable criteria for image content of images that can be used on said custom official postal stamp.

7. A system according to claim 1 wherein said information includes a selection menu for allowing selection of a prestored image for use on said custom official postal stamp .

8. A system according to claim 1 wherein said computer program allows the uploading of a custom image from said remote ordering system.

9. A system according to claim 7 wherein said computer program further includes means for allowing customizing of said prestored image at said at least one remote ordering system.

10. A system according to claim 8 wherein said computer program further includes means for customizing of said custom image.

11. A system according to claim 9 wherein said customizing of said prestored image includes the capability of selecting and/or modifying the shape, size, color, or orientation of said prestored image.

12. A system according to claim 10 wherein said customizing of said custom image includes the capability of selecting and/or modifying the shape, size, color, or orientation of said custom image.

13. A system according to claim 9 wherein said customizing of said prestored image further includes the providing of text on said custom official postal stamp.

14. A system according to claim 9 wherein said customizing of said custom image further includes the providing of text on said custom official postal stamp.

15. A system according to claim 1 wherein said information further includes providing a selection of a denomination from a predefined schedule of postal rates for said custom official postal stamp.

16. A system according to claim 15 wherein said computer program includes automatic means for modifying said selection of a denomination in accordance with revised postal rates.

17. A system according to claim 1 wherein said information includes an electronic order form for completion at said remote ordering system and electronically returning to said central authorizing computer system.

18. A system according to claim 17 wherein said computer program provides notification to said at least one remote ordering system when an order on said order form has been properly or improperly filled in.

19. A system according to claim 18 wherein said order form includes means for providing payment for said custom official postal stamp.

20. A system according to claim 17 wherein said order form includes information regarding contact means for allowing contacting of the originator of the order.

21. A system according to claim 17 wherein said means includes one of the following: phone number, address, e-mail address.

22. A system according to claim 1 wherein said computer program further includes means for creating a receipt of said order form.

23. A system according to claim 22 wherein said receipt includes one or more of the following: customer order identification, order information, facsimile of the image to be used on the custom official postal stamp.

24.(Once Amended) A system according to claim 1 wherein said computer program further comprises means for notifying said remote ordering system that the image submitted by said user has been authorized for use on said custom official postal stamp.

25. A system according to claim 24 wherein said authorization system comprises a verification computer system for entering of an identification number provided by said receipt for verifying acceptance or rejection of the order.

26. A system according to claim 1 further comprising a printing device for printing said custom official postal stamp by said authorizing computer system.

28. A system according to claim 8 wherein a portion of the custom image is combined with a prestored image.

29. A system according to claim 6 further comprising means for manipulation of the image for use on said official postal stamp.

30. A system according to claim 29 wherein said means for manipulation of said image comprises at least one selection button for incrementally moving the image a predetermined incremental amount in at least one direction.

31. A system according to claim 30 wherein said incremental amount comprises an amount from about 1% to about 5% of the size of said image.

32. A method for ordering a custom official postal stamp having a customized image thereon, comprising the steps of:

- a) providing a central authorizing computer system for communication with at least one remote ordering system over a communication network; and
- b) providing said central authorizing computer system with a computer program for providing information to said at least one remote ordering system for allowing ordering of a custom official postal stamp by a user from said at least one remote ordering system wherein the user provides an image for incorporation as a part of said official postal stamp.

33. A method according to claim 32 further comprising the step of:

ordering of said custom official postal stamp at said at least one remote ordering system based on instructions and selections provided by central authorizing computer system.

34. A method according to claim 33 wherein said various instructions and/or selections includes an electronic order form, further comprising the step of:

filling out said electronic order form and electronically returning said electronic order form to said central authorizing computer system.

35. A method according to claim 34 further comprising the step of:

providing an electronic receipt to said at least one remote ordering system by said central authorizing computer system.

36. A method according to claim 35 wherein said electronic receipt includes one or more of the following: customer order identification, order information, facsimile of the image to be used on the customized official postal stamp.

37. A method according to claim 32 further comprising the step of:

reviewing a custom image at said remote computer system prior to uploading said custom image to said central authorizing computer system.

38. A method according to claim 32 further providing the step of:

uploading a custom image from said remote ordering system to said central authorizing computer system.

39. A method according to claim 38 further comprising the step of:

obtaining approval to use said image on said custom official postal stamp from said central authorizing computer system.

40. A method according to claim 34 further comprising the step of:

printing said custom official postal stamp in accordance with said electronic order form after obtaining approval from said central authorizing computer system.

41. A method according to claim 39 further comprising the step of:

accessing said central authorizing computer to determine if approval to use said image has been obtained.

42. A computer software product for use in ordering custom official postal stamp, comprising a computer readable storage medium having a computer program for use in a central authorizing computer system capable of communication with at least one remote ordering system over a communication



network, said computer software product which when loaded into authorizing computer system causes the authorizing computer system to perform the step of:

providing said central authorizing computer system with a computer program for forwarding information to said at least one remote ordering system for allowing ordering of custom official postal stamp by a user from said at least one remote ordering system wherein the user provides an image for incorporation as a part of said official postal stamp.

43. A computer software product according to claim 42 wherein the computer software product further causes the computer to perform the additional step of:

ordering of said custom official postal stamp at said at least one remote ordering system based on instructions and selections provided by central authorizing computer system.

44. A computer software product according to claim 43 wherein said computer software product further causes the computer to perform the additional step of:

providing an electronic receipt to said at least one remote ordering system by said central authorizing computer system.

45. A computer software product according to claim 42 wherein the computer software product further causes the computer to perform the additional step of:

allowing said remote computer system to customize images for use in custom official postal stamps.

46. A computer software product according to claim 44 wherein said electronic receipt includes one or more of the following: customer order identification, order information, facsimile of the image to be used on the customized official postal stamp.

47. A computer software product according to claim 42 wherein the computer software product further causes the computer to perform the additional step of:

reviewing a custom image at said remote computer system prior to uploading said custom image to said central authorizing computer system.

48. A computer software product according to claim 42 wherein the computer software product further causes the computer to perform the additional step of:

uploading a custom image from said remote ordering system to said central authorizing computer system in order to obtain approval to use said image on said customized official postal stamp.

49. A system for ordering customized official postal stamp, comprising:

a central authorizing computer system for communicating with at least one remote ordering system over a communication network, said central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system by a user for allowing custom modification of an image for use on customized official postal stamp.

50. A system for customizing an official postal stamp, comprising:

a central authorizing computer system for communicating with at least one remote ordering system over a communication network, said central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for allowing customizing of an customized official postal stamp from said at least one remote ordering system, and means for manipulation of the image for use on said customized official postal stamp.

51. A system according to claim 50 wherein said means for manipulation of said image comprises at least one selection button for incrementally moving the image a predetermined incremental amount in at least one direction.

52. A system for customizing an official postal stamp, comprising:  
  
a central authorizing computer system for communicating with at least one remote ordering system over a communication network, said central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for allowing customizing of an official postal stamp by a user from said at least one remote ordering system, means for manipulation of the image by the user for incorporation on said official postal stamp and means for producing an order receipt for order of a postal stamp, said receipt having a identification bar code thereon.

53. A system according to claim 52 wherein said system further includes a reader for reading said identification bar code so as to provide the status of said order.

54. A system for customizing an official postal stamp, comprising:  
  
a central authorizing computer system for communicating with at least one remote ordering system over a communication network, said central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for allowing customizing of an official postal stamp by a user from said at least one remote ordering system,

said central authorizing computer system having at least one image provided by said user that can be used in a custom official postal stamp, means for manipulation or use of at least a portion of the prestored image for use on said custom official postal stamp.

55. A system for customizing an official postal stamp, comprising:

a central authorizing computer system for communicating with at least one remote ordering system over a communication network, said central authorizing computer system having a computer program for forwarding information to said at least one remote ordering system for allowing a user to customize an official postal stamp from said at least one remote ordering system, said central authorizing computer system having at least one prestored image that can be used in a custom official postal stamp, means for using at least a portion of the prestored image for use on said custom official postal stamp thereby eliminating the need to obtain content approval before producing of said official postal stamp.